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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,675	06/15/2001	Dennis J. O'Rear	005950-677	9491

7590

04/07/2003

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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

5

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,675

Applicant(s)

O'REAR, DENNIS J.

Examiner

Ellen M McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,392,108 B1 (O'Rear).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the method claimed in O'Rear of inhibiting oxidation of a Fischer-Tropsch product comprising the step of adding an effective amount of a temporary antioxidant selected from the group consisting of sulfides, disulfides, polysulfides, mercaptans, or mixtures thereof, to provide a blended product having a final peroxide number of less than 5 ppm after 7 days, results in a product which is indistinguishable from the products of the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alward (5,453,211).

Alward discloses that the oxidation stability of lubricating oil basestocks and formulated lubricant oils is improved by the addition of minor amounts of tetralins, alkylated tetralins or mixtures thereof, or their combination with organic sulfides to the oil. Alward teaches that suitable lubricating oils may be obtained from any source such as natural naphthenic or paraffinic petroleum hydrocarbon oils and wax isomerate oils produced by the hydro-isomerization of slack waxes or hydrocarbon synthesis waxes such as Fischer-Tropsch waxes. See column 1, lines 5-18 and column 2, lines 47-61. Alward teaches that an amount of organic sulfide ranging from 0 to 0.1 weight %, based on the elemental sulfur content of the organic sulfide, may be used in combination with the tetralin or alkyl-substituted tetralin. Alward teaches that if the lubricating oils have been severely hydrotreated to reduce their inherent sulfur contents, the addition of organic sulfides of low to moderate molecular weight and low boiling point may be desirable which may later be removed by distillation from the oil prior to the oil being combined with commercial additive packages to produce a formulated oil. See column 3, lines 5-20. Thus, the examiner is of the position that Alward clearly meets the claim limitations of a Fischer-Tropsch product containing a temporary organic sulfide antioxidant, and that applicant's open-ended claim language "comprising" allows for the addition of other additives to the composition such as the tetralin components of Alward.

Claim Rejections - 35 USC § 103

Claims 1-22 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (WO 00/11116) or (WO 00/11117), in combination with Alward (5,453,211).

The Berlowitz et al ["Berlowitz"] references disclose blending a Fischer-Tropsch derived distillate fraction, which is essentially free of sulfur, with either a raw gas field condensate distillate fraction or a mildly hydrotreated condensate fraction to obtain a stable distillate fuel which has antioxidant properties. See page 4 of '11116. The sulfur content of the blended distillate is at least 1 ppm by weight, preferably at least 4 ppm and up to about 150 ppm by weight sulfur. See pages 6-7 of '11116. Peroxide numbers of the blended distillate are set forth in the examples and several examples have a final peroxide number of less than 1 after 28 days which is within the claimed value of less than 5 ppm after 7 days. Thus the examiner is of the position that the Berlowitz references appear to meet the limitations of the claims. The Berlowitz references, however, do not disclose removal of the temporary sulfur component as claimed by applicant. However, the examiner is of the position that, in view of Alward outlined above which discloses that the sulfur component may be removed by distillation from the oil prior to the oil being combined with commercial additive packages to produce a formulated oil, it would be obvious to the skilled artisan to remove the sulfur components from the blends of Berlowitz if so desired.

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Art Unit: 1764

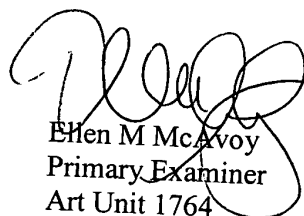
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
April 3, 2003